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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/769,432 | 01/26/2001 | Tetsuo Masubuchi | 0649-0771P | 5407 |
| 2292 | 7590 | 04/19/2004 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | SHORT, PATRICIA A | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1712 | | |

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/769,432 | MASUBUCHI ET AL. | |
| | Examiner | Art Unit | |
| | Patricia A. Short | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 March 2004.
2a) This action is **FINAL**. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8 and 11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-6 and 11 is/are rejected. °

7) Claim(s) 7 and 8 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

This Office Action is in response to an RCE filed March 15, 2004. The amendment filed February 17, 2004 under 37 CFR 1.116 has been entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Imai (5,216,074). The reference teaches thermoplastic elastomer compositions that comprise hydrogenated block copolymer having a polybutadiene block and a block that can be a styrene/butadiene copolymer, modified olefin having an epoxy group and a polyester elastomer. The compositions optionally contain an additional rubbery compound that can be an olefin based thermoplastic elastomer. See col. 19, line 7 through col. 20, line 26 and Example 30 in Table 6. Use of a hydrogenated block copolymer that contains styrene is anticipated by or would have been obvious over the teachings of the reference. Additionally, the olefin based thermoplastic elastomer encompasses the EPDM used in Example 30.

Applicant argues that the reference teaches away from the use of SBS block copolymer. However, it is not clear that the language styrene-butadiene block copolymer excludes a block copolymer having a styrene-butadiene block and a butadiene block as taught by Imai, i.e. the claims do exclude the use of comonomers to form the styrene block. Applicant further argues that the language “consisting essentially of” with respect to the copolymer of ethylene and propylene excludes the EPDM used by Imai. The EPDM used in Example 30 of the reference is

EP98A (see Table 4 footnote 26). As evidenced by U.S. 2002/0177659 (cited below), EP98A is an ethylene-propylene-5-ethylidene norbornene copolymer rubber, a copolymer consisting essentially of ethylene and propylene. As disclosed at page 27, second paragraph, of the specification, olefin elastomer for use in the invention includes ethylene-propylene-5-ethylidene norbornene copolymer. Thus, it does not appear that 5-ethylidene norbornene affects the novel and basic characteristics of the invention and therefore, is not excluded by the language "consisting essentially of".

Additionally, Example 30 discloses a combination of polyester elastomer, polyolefin modified with an epoxy and EPDM, an olefin elastomer, that is a preferred combination for component B used in the Elastomer Composition VIII discussed at columns 19 and 20. As ethylene/propylene rubber is a common olefin elastomer and, as disclosed at col. 12, lines 14-17 of Imai, is equivalent to ethylene/propylene/diene rubber (EPDM) for use in the reference compositions, it would have been obvious to substitute ethylene/propylene rubber for the EPDM used in Example 30 of the reference with the expectation of obtaining a thermoplastic elastomer composition having similar properties.

Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

U.S. 2002/0177659 cited as evidence that EP98A is an ethylene-propylene-5-ethylidene norbornene copolymer rubber. See paragraph 0048.

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PRIMARY EXAMINER

